

REMARKS

Applicant has carefully reviewed the Office Action mailed September 10, 2007 and offers the following remarks. Applicant concurrently files a Declaration of the inventor, Dany Sylvain, and a Declaration of Benjamin S. Withrow, Assignee's outside patent attorney who drafted the present application, under 37 C.F.R. § 1.131.

Applicant wishes to thank the Examiner for indicating that claim 5 would be allowable if rewritten in independent form. Applicant reserves the right to rewrite claim 5 at a later time.

Claims 1-4 and 6-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,058,415 B2 to Bushnell et al. (hereinafter "Bushnell") in view of U.S. Patent No. 6,154,650 to Abidi et al. (hereinafter "Abidi") and further in view of U.S. Patent No. 6,327,470 B1 to Ostling (hereinafter "Ostling"). To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable. Applicant respectfully traverses because Bushnell is not prior art to the present invention under 35 U.S.C. § 102(e).

For a reference to be considered prior art under 35 U.S.C. § 102(e), the statute requires that the invention be "...described in (1) an application for patent, published under section 122(b), by another filed in the United States **before the invention by the applicant for patent**" (emphasis added). However, Applicant conceived of the present invention prior to the filing date of Bushnell, and constructively reduced the present invention to practice through the filing of provisional application Serial No. 60/472,277 (hereinafter "the Provisional Application"), to which the present application claims priority. As such, Bushnell does not qualify as prior art under § 102(e).

In order to establish that Bushnell does not qualify as prior art under § 102(e), Applicant herein presents the Declaration of the inventor, Dany Sylvain, under 37 C.F.R. § 1.131, illustrating conception of the present invention prior to the filing date of Bushnell. Applicant also presents the Declaration of Applicant's representative, Benjamin S. Withrow, the patent attorney who drafted the present application, to be used in conjunction with the Declaration of the inventor, Dany Sylvain. These declarations show diligence from a time prior to the filing date of the Bushnell reference through a constructive reduction to practice of the present

invention by the filing of the present application and the Provisional Application to which the present application claims priority.

Based on the Declarations, Applicant asserts that the present invention was conceived of as early as April 23, 2003. Inventor Dany Sylvain conceived of the Present Invention as early as April 23, 2003, the date when Mr. Sylvain completed the Invention Disclosure and submitted it to the Intellectual Property Law Department at Nortel (See Declaration of Dany Sylvain, Paragraphs 2-5, and Appendix A). Appendix A to the Declaration of Dany Sylvain (hereinafter "Invention Disclosure") references and builds upon an earlier invention disclosure, which is dated December 19, 2002 (hereinafter "the 15795 invention disclosure") (See Declaration of Dany Sylvain, Paragraph 4, and Appendix B). The Invention Disclosure indicates that the 15795 invention disclosure describes how to transfer a wireline/WLAN call to a cellular network to a pre-configured number associated with a handset when in cellular mode. The Invention Disclosure adds the new feature that the same public phone number can be used for both networks, removing the need for a pre-configured number (see Declaration of Dany Sylvain, Appendix A, p. 2). The features added by the Invention Disclosure can be discerned from the slides that are part of the Invention Disclosure. Thus, the Invention Disclosure, together with the 15795 invention disclosure, clearly shows conception of each of the limitations of the present invention, as seen below with respect to representative claim 1¹:

A method for transitioning a call with a dual mode mobile terminal from a wireline network to a wireless network, wherein the mobile terminal is provided with a primary directory number associated with the wireline network (see Invention Disclosure, p. 2, and p. 6 (slide 4)), the method comprising:

- a) receiving a request for a temporary directory number, which has been temporarily assigned to the mobile terminal by the wireless network (see Invention Disclosure, p. 6 (slide 4, steps 2b and 3));
- b) accessing the temporary directory number (see Invention Disclosure, p. 6 (slide 4, steps 2b and 3)); and

¹ Independent claim 15 is directed to a system, but has the same limitations as claim 1, and therefore was also conceived of at least as early as April 23, 2003, as shown in the Invention Disclosure.

c) providing the temporary directory number during the call to allow a wireless connection to be established with the mobile terminal via the wireless network (see Invention Disclosure, p. 6 (slide 4, steps 4, 5, and 6)).

Thus, as seen above, at least as early as April 23, 2003, before the May 12, 2003 filing date of Bushnell, Mr. Sylvain had conceived of the invention claimed in the present application.

Further, the declarations show that from a date prior to May 12, 2003 (the filing date of Bushnell), diligent action was taken by Applicant's representative, Benjamin S. Withrow, the inventor, Mr. Sylvain, and the assignee of the present application to constructively reduce the invention to practice through the filing of the Provisional Application on May 21, 2003, as well as the instant patent application on October 24, 2003. (See Declaration of Benjamin S. Withrow, Paragraphs 3-14; and Declaration of Dany Sylvain, Paragraphs 6-12). In particular, the assignee of the present invention received the Invention Disclosure submitted by Mr. Sylvain on April 23, 2007, and reviewed the Invention Disclosure in the ordinary course of its first in, first out policy regarding invention submissions on May 7, 2003 (see Declaration of Dany Sylvain, paragraph 5 and Appendix C). The assignee then sent instructions to Benjamin S. Withrow, of the law firm of Withrow & Terranova, PLLC, instructing him to prepare and file a provisional patent application for the Invention Disclosure (see Declaration of Benjamin S. Withrow, Paragraph 3). Mr. Withrow had received instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures prior to May 2003 (see Declaration of Benjamin S. Withrow, Paragraph 5). From the time of receiving the instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures, until about October 24, 2003, Mr. Withrow worked to prepare patent applications for the number of previous Invention Disclosures in essentially a chronological, first-in-first-out fashion (see Declaration of Benjamin S. Withrow, Paragraph 6).

Starting from a period after May 7, 2003, and continuing through May 21, 2003, Mr. Withrow diligently reviewed the Invention Disclosure, spoke with the inventor Mr. Sylvain, and diligently worked to prepare a provisional patent application for the Invention Disclosure (Declaration of Benjamin S. Withrow, paragraph 7; see also Declaration of Dany Sylvain, paragraph 6). The Provisional Application was filed on May 21, 2003 as Serial No. 60/472,277 and was directed to the subject matter of the Invention Disclosure. *Ibid.* The Provisional Application also incorporated by reference U.S. Patent Application Serial No. 10/409,290, which

is directed to the subject matter of the 15795 invention disclosure. *Ibid.* The Provisional Application fully discloses the claims of the present invention. *Ibid.*

Mr. Withrow then received instructions from Nortel on June 20, 2003, to prepare and file a regular utility application that claimed priority to the Provisional Application (Declaration of Benjamin S. Withrow, paragraph 8 and Appendix C; see also Declaration of Dany Sylvain, paragraph 7 and Appendix D). Starting from June 20, 2003, and continuing through October 24, 2003, Mr. Withrow diligently reviewed the Invention Disclosure, met with the inventor Dany Sylvain, and diligently worked to prepare a regular utility patent application that claimed priority to the Provisional Application and claimed the invention disclosed in the Invention Disclosure. (Declaration of Benjamin S. Withrow, paragraph 8; see also Declaration of Dany Sylvain, paragraph 8).

The diligent work by Mr. Withrow resulted in a first draft of the Patent Application, which was sent to the inventor on July 30, 2003 (see Declaration of Benjamin S. Withrow, Paragraph 9 and Appendix D; see also Declaration of Dany Sylvain, Paragraph 9 and Appendix E). Between July 30, 2003, and August 25, 2003, the inventor, Mr. Sylvain, then reviewed the draft application and provided comments regarding the First Draft to Mr. Withrow (see Declaration of Benjamin S. Withrow, Paragraph 10 and Appendix E; see also Declaration of Dany Sylvain, Paragraph 9). On August 25, 2003, Mr. Withrow revised the Patent Application to incorporate the comments from the inventor and sent a revised Patent Application to in-house counsel at Nortel Networks Limited, the assignee (see Declaration of Benjamin S. Withrow, Paragraph 11 and Appendix E). A copy of the revised Patent Application and the inventor declaration and assignment document was also sent on August 25, 2003 to the inventor for his signature (see Declaration of Benjamin S. Withrow, Paragraph 12 and Appendix E; see also Declaration of Dany Sylvain, Paragraph 10). On October 24, 2003, after having received a signed inventor declaration and assignment document from the inventor, and approval from in-house counsel at Nortel Networks Limited to file the Patent Application substantially as drafted in the Patent Application sent to in-house counsel on August 25, 2003, the Patent Application was filed with the U.S. Patent & Trademark Office and was assigned Application Serial Number 10/954,060 (Declaration of Benjamin S. Withrow, Paragraphs 13-14 and Appendix E). The Patent Application claimed priority to the Provisional Application and also incorporated by reference the disclosure of the 15795 invention disclosure (Declaration of Benjamin S. Withrow,

Paragraph 14). Thus, from a date prior to May 12, 2003, the filing date of Bushnell, diligent action was taken by Applicant's representative, Benjamin S. Withrow, the inventor, Mr. Sylvain, and the assignee of the present application to constructively reduce the invention to practice through the filing of the Provisional Application on May 21, 2003, as well as the filing of the instant patent application on October 24, 2003.

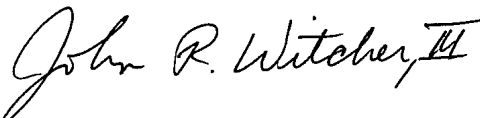
The filing date of the Bushnell reference is May 12, 2003. Based on the declarations and the above facts, Applicant respectfully submits that the date of invention for the present application was prior to May 12, 2003 and that diligent action was taken from a time period prior to May 12, 2003, through the filing of the Provisional Application on May 21, 2003, as well as the filing of the instant patent application on October 24, 2003, to constructively reduce the invention to practice. Therefore, Bushnell was not filed before Applicant's present invention. Thus, Bushnell does not qualify as prior art under 35 U.S.C. § 102(e). As such, the rejection of claims 1-4 and 6-32 as being unpatentable over Bushnell in view of Abidi and Ostling is improper and should be withdrawn. Applicant reserves the right to address Bushnell, alone or in combination with Abidi and Ostling, in the future if required.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:



John R. Witcher, III

Registration No. 39,877

100 Regency Forest Drive, Suite 160

Cary, NC 27518

Telephone: (919) 238-2300

Date: December 10, 2007

Attorney Docket: 7000-271